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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10397-141

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on

September 15, 2005

Signature

Ann Gillespie

Typed or printed name

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Application Number

09/820,054

Filed

March 28, 2001

First Named Inventor

Adam R. Schran

Art Unit

2161

Examiner

Etienne Leroux

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒

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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

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\*Total of 1 forms are submitted.

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1. There is a clear error in the Examiner's Final Rejection because none of the applied references disclose or suggest the limitations in claims 1 and 16 directed to a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine.

a. Montulli: Montulli fails to disclose or suggest the limitations in claims 1 and 16 directed to a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine, for at least the reasons given in Applicants' Response filed April 20, 2005 (mailroom date is April 22, 2005), hereafter, referred to as "the 4/22/05 Response."<sup>1</sup> See the arguments spanning pages 2-3 of the 4/22/05 Response.

On page 13 of the Final Rejection, the Examiner now refers to Fig. 5 of Montulli as allegedly disclosing downloading a list of cookie file sources from a server to a client machine. Applicants are unclear whether the Examiner relies on this disclosure in place of Hsu, or in addition to Hsu. Clarification of this new reasoning is requested if the Final Rejection is not withdrawn. Notwithstanding the reasoning used by the Examiner, Fig. 5 of Montulli merely supports the previously given arguments that Montulli merely describes downloading only individual cookies (not a list of cookies), and then building a list of cookies at the local computer from the downloaded individual cookies. The new portion of Montulli now highlighted by the Examiner, namely, column 13, lines 7-14, clearly confirms this fact. Step 224 shows that one cookie related to a user-selected product is sent from the merchant server to the client machine (i.e., the browser). If more product browsing occurs (step 228), then another cookie is sent for the next user-selected product when step 224 occurs again, and so on. At no point in the process is a list of cookie files sent. One commonly recognized definition of a "list" is:

A series of names, words, or other items written, printed, or imagined one after the other: *a shopping list; a guest list; a list of things to do.*<sup>2</sup>

No possible interpretation of the process in Fig. 5 of Montulli would result in a list of cookie files being sent. That is, the sending of a plurality of cookie files one at a time at separate intervals of time and in response to separate requests cannot be a list of cookie files.

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<sup>1</sup> The Pre-Appeal guidelines request that prior submissions be referred to by paper number. However, no paper numbers are available to Applicants, nor does any other paper numbering scheme appear on the USPTO's PAIR web site.

<sup>2</sup> The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company.

Furthermore, the cookies sent in Fig. 5 of Montulli are cookie files, not cookie file sources. That is, the cookie files in Fig. 5 of Montulli describe a selected product. Nowhere does Montulli describe that the source<sup>3</sup> of the selected product (e.g., the merchant from which the selected product is available from) is part of the downloaded cookie. Thus, even if it could be argued that a plurality of individually downloaded cookie files constitutes a list of cookie files (and Applicants strongly disagree with such a characterization because it violates the definition of a “list”), the alleged list of cookie files would not be a list of cookie file sources. Lastly, even if the merchant information is part of the downloaded cookie file (although no such disclosure exists in Montulli of this feature), each cookie file will have the same merchant information since Fig. 5 is directed to a shopping application wherein the customer accesses an on-line merchant server to review and potentially purchase one or more products from the on-line merchant. Thus, again, there would be no list of cookie file sources in Montulli since there would only be one identified merchant.

In sum, the Examiner’s new citation of Fig. 5 of Montulli does not make up for any of the previous deficiencies in the other portions of Montulli relied upon by the Examiner.

b. Hsu: Hsu fails to disclose or suggest the limitations in claims 1 and 16 directed to a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine, for at least the reasons given in the 4/22/05 Response. See the arguments spanning pages 3-4 of the 4/22/05 Response.

On page 14 of the Final Rejection, the Examiner argues that the rejection was based on the combination of Montulli and Hsu, and thus Hsu cannot be attacked individually for failing to disclose downloading a list of cookie files sources from a server to a client machine.

Stated simply, the Examiner’s Final Rejection asserts that Montulli can be modified to provide a list of cookie file sources at a server and to download such a list because Hsu

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<sup>3</sup> See, the following commonly accepted definitions of a “source”:

1. The point at which something springs into being or from which it derives or is obtained.
2. The point of origin, such as a spring, of a stream or river. See Synonyms at *origin*.
3. One that causes, creates, or initiates; a maker.

The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company.

discloses providing a list of cookie files sources at a server. This reasoning is clearly erroneous for at least the following reasons:

i. Hsu does not disclose downloading the list of cookie files sources from the server to a client machine, and actually teaches away from such an action, as described in the arguments spanning pages 3-4 of the 4/22/05 Response. Therefore, Hsu fails to provide sufficient motivation to modify Montulli in this manner.

ii. The Examiner states that one motivation to modify Montulli so that the client machine receives a downloaded list of cookie files sources is to create “a system that would allow cookies to be updated routinely without having to “handshake” with the client,” and that this would be “a very desirable result in an environment where IP addresses change continuously.” Regardless of whether or not this would be a desirable system, it is not an invention concept described in Hsu, and thus it cannot form the basis for modifying Montulli to include a step in Applicants’ claimed invention.

c. Reha in view of Hsu: The combination of these references fail to disclose or suggest the limitations in claims 1 and 16 directed to a downloaded list of cookie file sources, wherein the list is downloaded from a server to a client machine, for at least the reasons given in the 4/22/05 Response. See the arguments on page 5 of the 4/22/05 Response.

In the “Response to Arguments” section of the Final Rejection, no additional comments were provided by the Examiner in response to Applicants’ substantive arguments in the 4/22/05 Response directed to this rejection. Accordingly, Applicants have no further comments regarding this rejection, other than to repeat the fact that Reha has nothing whatsoever to do with cookie files or cookie file sources, and thus the combination of Reha and Hsu is fundamentally flawed.

2. There is a clear error in the Examiner’s Final Rejection because none of the applied references disclose or suggest the limitations in step (c) of claims 7 and 22, and in step (a) of claims 12 and 27, namely, receiving at a client machine, from a service provider, a master list of cookie file sources.

Claims 7<sup>4</sup>, 12, 22 and 27 were rejected over the combination of Reha, Hsu and McCormick.

This set of claims is directed to a specific embodiment wherein a service provider sends a master list of cookie file sources to a client machine.

Turning to the specific grounds of rejection of claims 7 and 22, the Final Rejection states that column 2, lines 1-8 of Reha discloses “receiving at the client machine, from a service provider, a master list of cookie file sources.” This is a clearly erroneous statement. Column 2, lines 1-8 of Reha states that “[t]he method includes downloading a file that contains a list of software components from a remote server.” Software components have nothing whatsoever to do with cookie file sources.

Regarding claims 12 and 27, the Examiner refers again to column 2, lines 1-8 of Reha for the service provider step. However, the Examiner states that Reha does not disclose that the downloaded file is a file of cookie file sources, and relies upon Hsu to provide a motivation to modify Reha to download cookie file sources, instead of lists of software components. The rejection of claim 12 and 27 is thus based, in part, on the same fundamentally flawed reasoning as the rejection of claims 1 and 16 over Reha in view of Hsu.

Even if Reha’s remote server is presumed to be equivalent to a “service provider” (and Applicants do not agree with this assertion) claims 7, 12, 22 and 27 are believed to be patentable over the applied combination for the same reasons as given on page 5 of the 4/22/05 Response. McCormick was discussed at the top of page 6 of the 4/22/05 Response and fails to make up for any of the previously noted deficiencies in Reha or Hsu.

3. There is a clear error in the Examiner’s Final Rejection because Hsu’s priority date is insufficient to support a prima facie rejection of the claims when used in combination with Reha.

The reasons for this clear error are given in the 4/22/05 Response. See the arguments spanning pages 6-7 of the 4/22/05 Response.

On page 10 of the Final Rejection, the Examiner responded to Applicants’ procedural argument that portions of Hsu relied upon by the Examiner for this rejection did not exist in Hsu’s priority application. Specifically, the Examiner stated that the Office Action does not

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<sup>4</sup> The grounds of rejection at the bottom of page 4 of the Final Rejection refers to claims 2, 8-15, 17 and 20-30. However, in view of the detailed rejection of claim 7 on pages 5-6 of the Final Rejection, it is presumed that the grounds of rejection at the bottom of page 4 should have read claims 2, 7-15, 17 and 20-30.

reference the unsupported paragraphs [0062] and [0063], and only references database 32, paragraph [0058] and paragraph [0089], all of which are supported by Hsu's priority application.

With respect to the rejection of claim 1 and 16 over Montulli in view of Hsu, the Examiner's statement is correct. Applicants inadvertently referred to all outstanding rejections which are based upon Hsu, and hereby withdraw this statement with respect to only the Montulli in view of Hsu rejection of claims 1 and 16.

With respect to all of the remaining outstanding rejections based upon the Reha/Hsu and Reha/Hsu/McCormick combinations, the Examiner relied upon unsupported paragraphs [0062] and [0063] of Hsu, and therefore a clear error still exists with respect to these remaining outstanding rejections. See, for example, the following grounds of rejection:

| Independent claims | Grounds of Rejection              | Reference to paragraphs [0062] and/or [0063] in the Final Office Action |
|--------------------|-----------------------------------|---|
| 1 and 16           | Reha in view of Hsu               | page 4, lines 6-11  |
| 7 and 22           | Reha and Hsu in view of McCormick | page 5, last line   |
| 12 and 27          | Reha and Hsu in view of McCormick | page 7, lines 12-15   |

4. There is a clear error in the Examiner's Final Rejection of the dependent claims.

The dependent claims are believed to be allowable because they depend upon respective allowable independent claims, and because they recite additional patentable steps.

Likewise, the clear error with respect to the improper use of Hsu for unsupported paragraphs [0062] and [0063] requires the withdrawal of the dependent claim rejections based upon the Reha/Hsu and Reha/Hsu/McCormick combinations.

5. None of the arguments above depend upon interpretations of prior art teachings or claim scope issues. For at least the reasons set forth above, all of the outstanding rejections should be withdrawn.